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09/704,755	11/03/2000	Hideaki Furukawa	35.C10563 REI	4371

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EXAMINER
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PAN, DANIEL H

ART UNIT	PAPER NUMBER
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2183

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/704,755

Applicant(s)

FURUKAWA, HIDEAKI

Examiner

Daniel Pan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-153 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-86 is/are allowed.
- 6) ☒ Claim(s) 87-153 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 08/413,432.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

1. Claims 1-153 are presented for examination.
2. Claims 87, 96, are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.
3. As to claims 87, claim 87 is directed to the broadening aspect of the storage means for storing the control program which the peripheral apparatus uses to control the peripheral apparatus and the transfer means for transfer the control program received in response the transfer request thorough the channel, secured by eh securing means (see patented claim 1, see also the unamended original scope of claim 1)
4. The omitted features are :

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- a) reception means for receiving a transfer request from the information apparatus requesting that the control program stored in the storage means be transferred to the information apparatus through the network (claim 1, lines 9-11);
- b) secure means for securing a channel to the information processing apparatus through network on the basis of the transfer request (see claim 1 secure means);
- c) the secure means secured by the secure means on the network, the transfer request received by the reception means, the use of control program to generate control data for controlling the peripheral apparatus (see claim 1 transfer means).

5. Similarly, the newly added feature inquiry means for making an inquiry at the predetermined timing about whether or not the device driver was to be transferred of newly presented claim 87 is not related to the prior art rejection and not related to the subject matter surrendered in the original application. Therefore, impermissible recapture of the subject matter exist.

6. As to claims 96 (see also claim 105), claim 96 is directed to the broadening aspect of the storage in memory a control program which the peripheral apparatus uses to control the peripheral apparatus and the transfer means for transfer the control program received in response the transfer request thorough the channel, secured by the securing means (see patented claim 35, see original scope of claims 41,45 )

7. The omitted features are :

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- a) the receiving of a transfer request from the information apparatus requesting that the control program stored in the storage means be transferred to the information apparatus through the network (see patented claim 35, lines 7-10);
- b) the securing of a channel to the information processing apparatus through network on the basis of the transfer request (see claim 35, the step of securing a channel);
- c) the channel secured by the securing step on the network, the transfer request received by the receiving step, the use of control program to generate control data for controlling the peripheral apparatus (see claim 35 transferring the control program).

8. Similarly, the newly added feature of making an inquiry at the predetermined timing about whether or not the device driver was to be transferred of newly presented claim 96 (see also claim 105, the memory medium storing computer readable code in preamble) is not related to the prior art rejection and not related to the subject matter surrendered in the original application. Therefore, impermissible recapture of the subject matter exist.

9. As to claim 126, 130, 134, claims 126, 130, 134 are directed to the broadening feature of the guide means for designating priorities between unique information of the plurality of peripheral apparatuses and selection on the basis of the guide means (see patented claim 72, claim 72 included limitations of claim 71, see also claim 80, claim 80 included limitations of claim 79 ).

10. The omitted features are :

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a) the selection means for selecting open of plurality of apparatuses which is top print data on the basis of unique information (see claims 71 and 79);

b) the generation of data to be printed by one of peripheral apparatuses selected by the selection means (claims 71, 79).

11. Similarly, the newly added feature display control means for controlling the display device to display a GUI of newly presented claim 126 (see also claim 130, see also claim 134, the memory medium for storing the computer executable code) is not related to the prior art rejection and not related to the subject matter surrendered in the original application.

Therefore, impermissible recapture of the subject matter exist.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 87,91- 96, 100-105, 109-113 are rejected under 35 U.S.C. 102(a) and

(b) as being anticipated by Montejo et al. (5,161,222) .

13. As to claim 87,96, 105, Montejo disclosed a system including at least :

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a) storage means for storing device driver for peripheral device (see the data disk for storing device drivers in col.7, lines 9-17, see also the driver library in col.7, lines 49-58);

b) inquiry means for making inquiry at a predetermined time on network (e.g. see the LAN in fig.3 [42] , see also the request in col.7, lines 9-41, see col.8, lines 20-33, col.9, lines 10-22, see also gif.5 for loading a driver ) whether or not the driver was to be transferred from the storage to the external apparatus ;

c) transfer means for transferring the device driver from eh storage thought he network to the external apparatus if a reply was received (see the answer from the sensor in col.7, lines 23-30, the loading of a driver in col.10, lines 5-18, col.11, lines 10-33).

14. AS to claim 91,100, 109, Montejo also included print control for receive print data (see the printer control in col.9, lines 10-22).

15. As to claim 92,101, 110, Montejo also secured the channel (see the selection of serial port in col.18, lines 44-53).

16. As to claim 93,102, 111, Montejo also included communication session beg fore the securing the channel (see the keyboard interaction in col.16, lines 23-40).

17. As to claim 94,103, 112, Montejo also transfer plurality of drivers with the network (see the transfer of the drivers in the LAN in col.6, lines 64-68, col.7, lines 1-41).

18. As to claim 95, 104, 113, Montejo also included the predetermined timing ( see the timing in col.25, lines 14-34).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 88,97, 106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montejo et al. (5,161,222) in view of Kashiwagi (5,301,262) .

20. As to claim 88, 97, 106, Montejo did not specifically showed the digital copier as claimed. However, Kashiwagi disclosed a digital copier (see col.2, lines 35-41). It would have been obvious to one of ordinary skill in the art to use Kashiwagi in Montejo for including the digital copier as claimed because the use of Kashiwagi could provide Montejo the ability to adapt to different type of digital copier, and because one of ordinary skill in the art should be able to recognize digital copier could be applicable into the system based on the interface connection of Montejo for the peripheral devices , such as the printers, in order to enhance the processing structure of the system, and therefore, provided a motivation.

21. Claim 89, 90, 98,99, 107,108, 114 , 115,118, 119,122,123 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montejo in view of Hirasawa (5,341,363) .

22. As to claims 89,90,98,99, 107,108, 122,123, Montejo did not specifically show the IP address and the MAC as claimed. However, Hirasawa disclosed IP address and MAC (see col.1, lines 21-29). It would have been obvious to one of ordinary skill in



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the art to use Hirasawa in Montejo for including the IP address and MAC as claimed because the use of Hirasawa could provide Montejo the ability to accept specific format of address at the network, and thereby increasing the connection adaptability of the system, and it could be readily achieved by predefining IP and MAC address of Hirasawa with modified format (e.g. the address bit length and type) into the configuration file of Montejo so that the IP address and the MAC address of Hirasawa could be recognized by Montejo in order to enhance the adaptability of the system in Montejo, and in doing so, provided motivation.

23. As to claims 114,115, 118,119, Montejo disclosed at least :

- a) detection means for detecting information about an inquiry (request) made by peripheral apparatus through network (e.g. see the LAN in fig.3 [42] , see also the request in col.7, lines 9-41, see col.8, lines 20-33, col.9, lines 10-22, see also gif.5 for loading a driver);
- b) transmission means for transmitting information to the apparatus so as to secure a communication channel (see the selection of serial port in col.18, lines 44-53) if the information detected (see the output information for loading the driver in see also the request in col.7, lines 9-41, see col.8, lines 20-33, col.9, lines 10-22, see also gif.5 for loading a driver);
- c) control means for receiving a device driver for peripheral apparatus and placing the device driver under control of an operating system (see the operating system in col.6, lines 59-63, the loading of a driver in col.10, lines 5-18, col.11, lines 10-33).

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24. Montejo did not specifically show his information was IP address and the MAC as claimed. However, Hirasawa disclosed IP address and MAC (see col.1, lines 21-29). It would have been obvious to one of ordinary skill in the art to use Hirasawa in Montejo for including the IP address and MAC as claimed because the use of Hirasawa could provide Montejo the ability to accept specific format of address at the network, and thereby increasing the connection adaptability of the system, and it could be readily achieved by predefining IP and MAC address of Hirasawa with modified format (e.g. the address bit length and type) into the configuration file of Montejo so that the IP address and the MAC address of Hirasawa could be recognized by Montejo in order to enhance the adaptability of the system in Montejo, and in doing so, provided a motivation.

25. Claims 116, 117, 120, 121, 124, 125 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montejo in view of Hirasawa (5,341,363) as applied to claim 114, 118 above, and further in view of Kou (5,355,490).

26. As to claims 116, 120, 124, neither Montejo nor Hirasawa taught the GUI display as claimed. However, Kou disclosed a system including a window environment graphical user interface (see col.2, lines 6-14). It would have been obvious to one of ordinary skill in the art to use Kou in Montejo for including the GUI as claimed because the use of Kou could provide Montejo the capability to control the requested information in graphical option, thereby increasing the interface capability of the system, and it could be done by configuring the graphical user interface of Kou into

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Montejo with specific graphical objects recognizable by Montejo to achieved he flexible user interface, and therefore, provided a motivation.

27. As to claims 117, 121, 125, with discussions set forth above, Montejo should also be able to select one of the plurality of peripheral devices in GUI because Montejo also taught the selection of s[specific serial port (see the selection of serial port in col.18, lines 44-53).

28. Claims 126-129,130-137 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farrand et al. (5,559,958) in view of Shitby (3,988,719).

29. As to claims 126,130, 134, Farrand disclosed a system including at least:

a) reception means for receiving from each peripheral apparatus information unique to peripheral processing apparatus in a network (see col.7, lines 21-63);

b) displaying means to display GUI window (see fig.) for integrated information on plurality of peripheral processing apparatuses based on the received information (see figs.10-15);

c)designating means for designate g selection of the plurality of items (see driver objects) included in each peripheral apparatus (see the selection of the driver in col.205, lines 25-50, see also selection of logical and physical drive in col.202, lines 5-63, see also the drivers in fig.7B-1 ).

30. Farrand did not specifically show the optimization of the order of the peripheral devices based on the priority are displayed. However, Shitby disclosed an effective selection of the priorities between the peripheral machines ( see the effective

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selection of the peripheral machines in col.2, lines 3-12). It would have been obvious to one of ordinary skill in the art to use Shitby in Farrand for including optimized order based the priorities as claimed because the use of Shitby could provide Farrand the ability to display the peripheral apparatus information on Farrand's display in a predefined sequence, and therefore, increasing the effective use of the peripheral devices based on a given selection.

31. As to claims 127,131, 135, Farrand also included :

a) memory means for storing a plurality of device drivers(see the driver objects in col.205, lines 25-50, see disk drive array for background of memory storage in col.9, lines 14-30, see also the drivers in fig.7B-1 );

b) selection means for selecting one of the peripheral (see the selection of the driver in col.205, lines 25-50, see also selection of logical and physical drive in col.202, lines 5-63, see also the drivers in fig.7B-1);

c) generating means for generating print data using the device driver stored in the memory selected by selected means (see col.7, lines 24-34, see also printed report in col.196, lines 38-56 ).

32. As to claims 128, 132, 136, Farrand also included wait time (see the wait time in col.201, lines 46-57).

33. As to claims 129, 133,137, Farrand also included a plurality of GUI windows (see figs.10-15).

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34. Claims 138-153 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakahara et al. (5,172,244) in view of Sakata (4,905,098).

35. As to claims 138,141, 142, 144, 145, 146, 149, 150,152, the language "higher class apparatus " is read as apparatus in different order or with different assigned number. Nakahara disclosed at least :

a) a print update means for updating for each process a print count value indicating number of print (see fig.8B S20 SET NUMBER, see col.6, lines 9-39);

b) a trouble update means for updating for each print trouble (trouble indication in col.3, lines 55-64);

c) transmission means (see fig.8B [s32,s31] for transmitting trouble data (e.g. print mode such as plotter number ps, number of copies) until the print count reaches a predetermined value (s25) to a predetermined one of at least higher class apparatus [px] (see fig.8A s10 for higher apparatus in order px+1, see the transmission of mode data into the selected plotter ps in fig.8B, see col.6, lines 40-66, col.7,m lines 1-27);

d) reception means for receiving trouble data (see the flag indicating jam in col.6, lines 55-66);

e) displaying control means for comparison between the print count (see col.3, lines 55-64).

36. Nakahara did not specifically show his trouble data (see col.3, lines 60-65) included a number of troubles as claimed. Nakahara showed the print count and

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updated count (see the set number and count number in col.3, lines 56-64, col.6, lines 9-39). However, Sakata disclosed a system including a trouble count (see the jam counter in col.11, lines 18-34). It would have been obvious to one of ordinary skill in the art to use Sakata in Nakahara for including the number of troubles as claimed because the use of Sakata could provide Nakahara the ability to process the number of prints based on an additional condition in order to track the number of prints with the number of the troubled copies, such as the jammed paper, thereby increasing the processing adaptability of Nakahara, and it could be readily achieved by predefining the jam counter of Sakata with modified counter parameter (e.g. the counter port) into Nakahara so the jam counter could be recognized by Nakahara to achieve the enhanced adaptability.

37. As to claims 139, 143, 147, Nakahara also initialized his print count (see fig.8B).

38. As to claim 148, Nakahara also included unique information (see the plotter number ps).

39. As to claims 151, 153, Nakahara also included a selecting means for selecting one of the apparatuses (see the automatic selection of idle plotter in col.6, lines 50-68, col.7, lines 1-21).

40. Claims 1-86 are allowable over the art of record (see previous actions on record).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Pan whose telephone number is 703 305 9696, or the new number 571 272 4172. The examiner can normally be reached on M-F from 8:30 AM to 4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chan, can be reached on 703 305 9712, or the new number 571 272 4162. The fax phone number for the organization where this application or proceeding is assigned is 703 306 5404.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*21 Century Strategic Plan*

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PRIMARY EXAMINER  
GROUP